Remarks

This application seeks protection for certain novel compounds that are inhibitors of the serine protease, Factor Xa, and are useful for the treatment of thrombotic disorders. It is a division of the national stage of an international application, the claims of which were drafted in accordance with international practice. The claims in the parent application have been limited to one specific compound.

Applicants now wish to amend the application to bring it into conformity with United States patent practice.

Claims 14, 17, 18, 28, 29, 31 and 32 have been cancelled, without prejudice.

Claims 4 to 6, 9 to 13, 15 to 16, 19 to 25, 27 and 33 have been rewritten to remove improper claim dependencies.

Claim 2 has been amended to remove definitions also found in Claim 1. Claim 2 has been further amended by inserting the value "piperidin-4-yl (which may bear a 1-methyl substituent,)" in the definition of CHR_eR_f before "or indan-2-yl". Basis for this amendment may be found in the corresponding passage at page 8, lines 22 to 23 of the specification.

Claim 7 has been amended by inserting a definition for L, based upon page 11, line 16.

In Claim 11, a comma has been re-positioned correctly.

In Claim 21, minor grammatical corrections have been made.

New Claim 34 is based upon original Claim 14 and the claims that originally depended from it.

New Claim 35 is based upon original Claim 25 as it depended from original Claim 14

The specification has been amended to introduce a reference to the parent application, and to correct certain sub-paragraphs in which some chemical names were recited incorrectly. In the sub-paragraphs at page 27, lines 28 to 34, the definitions (ix), (x) and (xi) have been replaced with the more preferred definitions at page 29, lines 19 to 23. This conforms the definitions with page 24, lines 16 to 30 and page 29, lines 19 to 23. In the sub-paragraph beginning at page 28, line 12, the names of substituted phenyl groups that do not conform with the definition of R_2 in Claim 1 have been deleted. The Examiner is kindly asked to note that Applicants have simply deleted the incorrect names, rather than sought to correct them.

INFORMATION DISCLOSURE STATEMENT

As a means of complying with the duty of disclosure, Applicant's submit an "Information Disclosure Statement by Applicant" on PTO Form PTO/SB/08A for consideration by the Examiner. Since this statement is being submitted during the period specified in 37 C.F.R. § 1.97(b), no fee is due for this submission.

In accordance with 37 C.F.R. 1.98(d), it is believed that a copy of each cited reference may be found at in the file of the parent application. If this is incorrect, the Examiner is kindly requested to contact the undersigned to request copies.

Applicants would also like to provide the Examiner the following background information:

BACKGROUND INFORMATION

This application claims compounds first disclosed in PCT/GB00/02302, from which the parent of the present application claims priority under 35 U.S.C. § 119.

PCT/GB00/02302 has entered the U.S. national stage as U.S. patent application serial number 09/926,712. The claims in the 09/926,712 application have been amended so as not to read on any of the compounds originally claimed in the present application.

The parent of the present application was voluntarily limited to a single species, after a restriction requirement had been made. Applicants are unsure as to whether the restriction requirement continues to apply. They have filed a continuation application, which is pending as

serial number 10/754,923, and now this divisional application. If the restriction requirement continues to apply, Applicants plan to limit the claims in the continuation application to the invention identified as Group VIII in the restriction requirement in the parent. The claims in the present divisional application would then be directed to the subject matter not claimed in the parent or continuation. However, Applicants would first need clarification from the Examiner on whether Group VIII in the restriction requirement in the parent included all monocyclic carbocyclic Cy groups, or just phenyl groups.

The compounds were invented in the course of a research collaboration between Eli Lilly and Company (the assignee of record) and Protherics Molecular Design Limited (now Tularik Limited, a subsidiary of Tularik Inc). The predecessor company of Protherics Molecular Design Limited was Proteus Molecular Design Limited.

This application forms part of a portfolio of patent applications directed to serine protease inhibitors, some of which belong to Eli Lilly and Company, and some of which belong to Tularik Limited. The history of this portfolio traces back to a research project on serine protease inhibitors started by Proteus Molecular Design Limited. The undersigned is responsible for handling the applications in this portfolio.

A listing of the co-pending applications and patents in the portfolio is provided on the next page.

Co-Pending Lilly and Tularik Applications and Patents

Co-pending applications - Assigned to Eli Lilly and Company

09/926,712 (national stage of WO 00/76971)
09/926,716 (national stage of WO 00/76970 - abandoned)
10/030,188 (national stage of WO 01/96303)
10/030,186 (national stage of WO 01/96304)
10/030,189 (national stage of WO 01/96296)
10/477,192 (national stage of WO 02/100847)
10/754,923 (continuation of 10/030,187 - parent of this appln)
10/486,138 (national stage of WO 03/084929)

Co-pending applications and patents - Assigned to Tularik Limited

US 6262069 and **US 6420438** (national stage of WO 99/11657 and continuation)
09/988,082 (continuation-in-part of 09/485,678, WO 99/11658 and of WO 00/77027, publication no. US 2002/0055522 A1)
10/148,174 (national stage of WO 01/44226)
10/296,245 (national stage of WO 01/96305)
10/432,365 (national stage of WO 02/47762)

COMMUNICATION BY TELEPHONE

The undersigned's office is located in the United Kingdom, and hence the Examiner may have difficulty contacting him from the USPTO by telephone. If the Examiner wishes to speak with the undersigned by telephone, he can contact the undersigned by e-mail at martinahay@martin-a-hay.com, or leave a message with Linda McDonald at (317) 433 7140 (Eli Lilly and Company).

Favorable consideration of the application is requested.

Respectfully submitted,

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